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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,979	02/06/2001	David Jenkins	70496	3369

22242 7590 12/18/2002

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

*Response Due
3/18/03
D.G.*

EXAMINER

NICOLAS, FREDERICK C

ART UNIT PAPER NUMBER

3754

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED
FITCH, EVEN, TABIN
DEC 26 2002

Office Action Summary

Application No.

09/777,979

Applicant(s)

JENKINS ET AL.

Examiner

Frederick C. Nicolas

Art Unit

3754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 16-44 is/are pending in the application.
- 4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 16-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3&4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Applicants' election without traverse of Group I (Species A, claims 1-7 and 16-44), including the election of Subspecies A1 with traverse in Paper No.16 are acknowledged. Applicants' arguments with regard to Subspecies A1-A5 have been considered and found to be persuasive. Therefore, the restriction requirement with regard to Subspecies A1-A5 has been withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-21,24-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

I- As to claim 19, line 1, there is lack of antecedent basis for "the multiplexer". ✓

II- As to claim 24, line 3, it is unclear by what is meant by the claimed limitation "though". ✓

III- As to claim 24, lines 3-4, there is lack of antecedent basis for "the endo-adominal cavity". ✓

IV- As to claim 27, line 1, there is lack of antecedent basis for "the multiplexer". ✓

V- As to claim 29, line 1, there is lack of antecedent basis for "the multiplexer". ✓

VI- As to claim 35, there is lack of antecedent basis for the followings: "the endo-adominal cavity" as recited in line 3; "the impedance" as recited in line 18. ✓

VII- As to claim 41, line 17, there is lack of antecedent basis for "the impedance".

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Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

← A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. → The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1-7, 16-44 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 16-44 of copending Application No. 10/036978. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Testerman et al. (U.S. 5,843,147).

Testerman et al. discloses an implant device especially adapted for treatment of neuro-muscular tissue as best seen in Figure 4, which comprises an elongated body (12) with a distal end (24) and a proximal end (22), a plurality of micro-electrodes at the distal end (column 6, line 50-66), an electric connection terminal (16) at the proximal end for connection to a power source (200), a plurality of electrical conductors extending through the elongated body from the distal end to the proximal end, where each electrical conductor is attached to a single micro-electrode at the distal end (column 6, lines 50-59), where any selected pair of the plurality of micro-electrodes can be electrically connected to the electric connection terminal to form an electrical pathway between the electric connection terminal and the selected pair of the plurality of micro-electrodes and the neuro-muscular tissue to be treated (column 51-60, and as best seen in Figure 4), a switching device (210) such that the selected pair of the plurality of micro-electrodes can be used to form the electrical pathway (column 7, lines 8-22), the plurality of microelectrodes is greater than about 3 microelectrodes (14a-14e)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Testerman et al. (U.S 5,843,147).

Testerman et al. has all the features of the claimed invention except for the plurality of micro-electrodes is about 4 to about 20 micro-electrodes.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to duplicate the micro-electrodes of Testerman et al. as such, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. As per MPEP 2144.04

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Alt (U.S 5,653,734), Faupel, Stoller et al., Dahl et al., Gielen et al., Alt (U.S 5,928,269). Sluijter et al., King, Duysens et al., Spelman et al., Cigaina et al., Edwards, Jenkins and Corbett, III et al. disclose other types of implant device.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick C. Nicolas whose telephone number is (703)-305-6385. The examiner can normally be reached on Monday - Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mancene L Gene, can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is (703)-308-7766.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0861.

FN

December 10, 2002

 12/10/02

Gene Mancene
Supervisory Patent Examiner
Group 3700